

**AMENDMENTS TO THE DRAWINGS**

Figure 1 is amended to depict managing instant messaging between user entities. Further, Figures 2 and 3 are amended to include descriptive labels. No new matter is added. Replacement drawings showing amended figures which include the desired changes, without markings, are attached hereto.

**REMARKS**

The foregoing amendment amends the figures, amends claims 1-3, 7, 8, 11, 23 and 24, adds new claims 25-43, cancels claims 4-6 and 12-22 without prejudice and replaces the original title of the invention. No new matter is added.

Now pending in the application are claims 1-3, 7, 8, 11 and 23-43, of which claims 1, 23, 25, 34, 39 and 41 are independent. Claims 2-8, 22-41, 49-54, 59, 60 and 67-69 are withdrawn from consideration. The following comments address all stated grounds for rejection and place the presently pending claims, as identified above, in condition for allowance.

**Drawing Amendments:**

Figure 1 is amended to depict managing instant messaging between user entities. Further, Figures 2 and 3 are amended to include descriptive labels. Applicant contends that no further descriptive labels are needed as each and every element depicted in the drawings includes a reference numeral. No new matter is added. Replacement drawings showing amended figures which include the desired changes, without markings, are attached hereto.

**New Title of the Invention:**

Although Applicant considers the original Title of the Invention descriptive of the invention, Applicant files herewith a new replacement Title of the Invention to facilitate prosecution of the instant application.

**Claim Amendments:**

Independent claim 1 is amended to include the feature of the message including text which is to be displayed in association with the selected track. The dependent claims are 2, 3, 7, 8, 11, 30, 31, 32 and 33.

Independent claim 23 is an amended version of original claim 23, with a dependent claim 24.

Independent claim 25 is based on original claim 1, but including the feature of a confirmation text message being transmitted. There are dependent claims 26, 27, 28, and 29.

Independent claim 34 is based on original claim 1, but including the feature of a track search. There are dependent claims 35, 36, 37 and 38.

Independent claim 39 is based on original claim 1, but is directed to the use of SMS text messaging. There is a dependent claim 40.

Independent claim 41 approaches the invention from the aspect of how the jukebox apparatus and a person interact. There are dependent claims 42 and 43.

No new matter is added.

Amendment and/or cancellation of the claims is not to be construed as an acquiescence to any of the objections/rejections set forth in the instant Office Action, and was done solely to expedite prosecution of the application. Applicant reserves the right to pursue the claims as originally filed, or similar claims, in this or one or more subsequent patent applications.

### **35 U.S.C. §102 REJECTIONS**

In the Office Action, the Examiner rejects claims 1-6 and 8-24 under 35 U.S.C. §102(e) as being anticipated by Published U.S. Patent Application No. 2002/0194564 of Uchiyama *et al.* (hereinafter "Uchiyama"). Applicants traverse the rejection and submit that the pending claims distinguish patentably over the cited references.

Claim 1 is independent and claims 2-6 and 8-22 depend, directly or indirectly, therefrom. Further, the above amendment cancels claims 4-6, 9, 10 and 12-22. Accordingly, Applicant considers the rejection of claims 4-6, 9, 10 and 12-22 under 35 U.S.C. §102(e) moot.

Claim 23 is independent and claim 24 depends therefrom.

Uchiyama discloses a centralized system for enabling a user to have access to audio / visual data at a venue. A personal telecommunications device such as a cellular mobile phone, a fixed phone using a conventional phone line, or an internet phone. *See* paragraph 0027. The interaction between the user and the central database is made using the keypad on the phone. *See*, paragraph 0029. After a selection is made, the selected data is transmitted to a digital

display device. *See*, paragraph 0030. As can be seen in Figure 1, 2 and 8, the display is distinct from the telecommunications device, and as explained in related passages, the digital display device 1 is "installed in a remote location open to the general public such as a bar, coffee shop, restaurant or other commercial establishment". *See*, paragraph 0027. It is said that "the digital display device 1 can be a PC, television or a plasma display panel that has a big and wide screen". It also includes a speaker system.

Paragraph 0032 of Uchiyama explains how the system interacts with the user. Once a connection is established after user dials a number on the display device, "the distribution server outputs a series of menus, options etc. to be displayed on the display device ". The end user "is prompted to make a music selection". The end user makes a selection by interacting using the keypad on the phone to enter numbers in accordance with prompts given on the display device 1. There may also be a voice message on the phone, telling the user to select an option from the menu on the display device 1 at the venue. *See*, paragraph 0051.

Once a track has been selected, it is downloaded to the venue and played using the display device / speakers.

This is an unsatisfactory arrangement. It relies entirely on downloading tracks over the Internet, interaction may involve voice messages on a telephone, which can be difficult to hear in a crowded venue, and in a most inconvenient fashion the interaction between the user and the system is displayed on the display device, which is typically a large screen at the venue. Whilst the user is making a selection, going through menus and so forth, that is what the display device displays. Other users cannot view the display at the same time to see a track, or to make their own selections. It is a system that might be of use for individuals in hotel rooms, or in private booths, or in airline seats for example, and this is borne out by the fact that the system is said to be applicable to playing interactive games. *See*, paragraph 0027. In a busy venue such as a bar which shows music videos, for example, the system would not be appropriate. Other people want to watch the music videos or other information on the display screens, not follow the interactions of somebody else with the system, and especially not watch them playing their own video games.

Using a touch tone telephone keypad to interact with a remote data processing system also a continuous connection over the telephone network whilst interaction takes place. It is, of course a well known method of interacting with a system. What Uchiyama adds is the possibility of using a separate display device connected to the remote system over the Internet, to provide a

visual indication of menu options, rather than just the voice messages that are normally hear which spell out the options.

The present invention uses a totally different approach, and is truly applicable in situations where a jukebox is desired - a jukebox that can play tracks continuously, whilst people can also select them continuously. The present invention relies instead on using a portable communications device such as a mobile telephone to achieve all forms of interaction - whether it is sending a track request to the jukebox, or the jukebox providing information to the user. A display at the venue is not required to enable interaction with the user. If the venue has a display linked to the jukebox, it can display a corresponding video for a track being played, or other information of interest to all users at the venue.

Considering amended claim 1 it is now made clear that the claim relates to a system that involves the use of jukebox apparatus. Whilst the present invention is capable of use in an arrangement in which some tracks can be downloaded to the jukebox apparatus, there are locally stored tracks, to reduce access time and avoid the need to be permanently connected to the Internet, downloading every track that is requested, as is necessary in Uchiyama. In accordance with claim 1, there is jukebox apparatus at a venue, and tracks are stored on the jukebox apparatus at the venue.

As amended, claim 1 specifies that in addition to the track identification code in the text message sent by the user, there is also associated alphanumeric text input by the user, to form a message which will be displayed at the venue in association with the track. The sent text message is scanned to identify both the track code and the message that is to be displayed. Whilst Uchiyama may display text associated with a track, that text is not a message input by the person requesting the track. It is text which the jukebox system has programmed into it, such as the name of the track and the artist. In relation to original claim 5, the Examiner says that Uchiyama meets the requirement claimed in that claim, namely that "the information transmitted further comprises an associated message". However, in amended claim 1 it is clear that the information is transmitted by a person to the jukebox, not from the jukebox to the person. Uchiyama enables a keypad to transmit options, but nowhere discloses sending messages to be displayed on the display screen at the venue. There is no system disclosed or suggested in Uchiyama which will enable a user to put in text such as a greeting, which will be displayed when that user's selected track is played. Furthermore, in Uchiyama the user does not input text at all, but just presses keys on the telephone keypad in the same manner as would be done when selecting options

within a telephone answering system. When using a text enabled mobile communications device such as a mobile telephone, the user can see the text that the user has input, and can then send it.

In accordance with the invention of amended claim 1, an associated message can be displayed in association with the selected track - such as "Happy Birthday Debbie, Love Tom" - an example given in the present application. In Uchiyama it would be totally impractical to have such a feature. Input is made using a phone keypad, but the display side of interactions is handled by the public display panel that has a big and wide screen. It would not be possible to compose a message to be shown as a surprise when a track plays. Everybody in the venue would see the message as it is being prepared, including the recipient for whom it is supposed to be a surprise.

Dependent claim 2 specifies that a mobile telephone network is used, and claim 3 specifies that Short Message Service (SMS) text messaging is used.

Dependent claim 8 recites that a confirmation text message is transmitted back to the user. In Uchiyama, the selection of a track is done whilst looking at the display in the venue, and the user can see that a track has been selected. In accordance with the invention of claim 1, interaction uses the mobile communications device, and with a confirmation text message sent back to the mobile communications device the user will know that the request has been received. This is not disclosed or suggested in Uchiyama, and there is no need for it given that track selection uses a separate display.

As regards original claim 8, the Examiner says that in Uchiyama, a confirmation is sent to the user once the request is received, and refers to paragraphs 0054, 0056 and 0058. Paragraphs 0056 and 0058 concern the configuration of the system by the owner of an establishment, and do not mention confirmation of the selection of a track to a user who has made a track selection. Paragraph 0054 does not concern confirmation of a choice, because Uchiyama does not require such a confirmation message. In Uchiyama, interaction with a user requires the use of the public display and a menu system. The user goes through the menu on the display screen, to select the track to be paid. Once a track has been selected, it is played. In accordance with the present invention, a text message is sent with the code of the requested track, and a return text message is sent confirming receipt of the request. Amended claim 8 now makes it clear that the confirmation message is a text message transmitted over the network to the mobile communications device.

Dependent claim 10 specifies that the messages are Short Message Service (SMS) text messages.

Independent claim 23 remains unchanged. The claim recites the use of a text message containing the code for the selected product or service, something which is nowhere suggested in Uchiyama, and is discussed above in the context of claim 1, for example. Claim 23 further recites the sending of a confirmation text message from the provider's data processing means, which again is something that is not disclosed in Uchiyama and is discussed above in the context of claim 8. Dependent claim 24 limits the system to a jukebox, as with claim 1.

For at least these reasons, Uchiyama does not anticipate claims 1-6 and 8-24.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claims 1-6 and 8-24 under 35 U.S.C. §102(e).

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)**

In the Office Action, the Examiner rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over Uchiyama in view of Published U.S. Patent Application No. 2002/0133562 of Newnam *et al.* (hereinafter "Newnam"). Applicants traverse the rejection and submit that the pending claim distinguishes patentably over the cited references.

Claim 7 depends from independent claim 1 and therefore incorporates the patentable subject matter of independent claim 1.

Claim 7 recites the use of a filter for offensive language. Whilst as such a filter is known from Newnam, this is not in the context of attaching a message to a jukebox track request.

For at least this reason, neither Uchiyama nor Newnam, alone or in combination, detract from the patentability of claim 7.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 7 under 35 U.S.C. §103(a).

**NEW CLAIMS**

Dependent claim 30 recites an alternative communication protocol disclosed in the application, the Wireless Application Protocol (WAP).

Dependent claim 31 recites the features of a track search system. Uchiyama has a menu system for selecting track, by going through selections for music type, artistes and so forth. However, it requires the use of the display screen. Whilst one user is going through the menu options on the display screen, another user cannot interact with the screen, watch a video track, and so forth. The use of text messages means that searches can be conducted personally by one user, who can look at the search results on the mobile communications device, without interfering with the enjoyment of others who want to view the display for e.g. a music video. Uchiyama does not suggest the arrangement recited in claim 31.

Claim 32 is a claim dependent on claim 31, reciting the confirmation feature discussed above in relation to claim 8.

Claim 33 recites that all of the text messages are SMS text messages.

Independent claim 25 is new and in addition to using a text message to select a track, a confirmation text message is provided. The use of text messages to request tracks is nowhere suggested in Uchiyama, as discussed above in relation to claim 1, and the use of a conformation text message is also something that is not disclosed in Uchiyama, as discussed above in the context of claim 8.

Dependent claims 26, 27, 28 and 29 recite features discussed earlier in the context of other claims.

Independent claim 34 is new, and in addition to using a text message to select a track, a search feature is provided using text messages. This is discussed above in the context of claim 31, and the use of text messaging to implement a search function is nowhere suggested in Uchiyama.

Dependent claims 365, 36, 37 and 38 recite features discussed earlier in the context of other claims.



Independent claim 39 is new and is specifically limited to the use of SMS text messaging. As compared to Uchiyama, storing tracks locally and requesting tracks by SMS text messaging using a mobile telephone has distinct advantages and is not suggested by Uchiyama. In Uchiyama there is a display at the venue and speakers to listen to music, presumably with an amplification system. However the heart of the jukebox apparatus, that performs all of the processing and stores all of the music, is located somewhere else. Tracks that have been selected are downloaded to the venue. Whilst downloading unavailable tracks is a possibility with a system in accordance with the invention, in accordance with claim 39, tracks are stored locally.

In Uchiyama, interaction may involve voice messages on a telephone, which can be difficult to hear in a crowded venue, or pressing keys in the manner of selecting options in a telephone answering system. Using a touch tone telephone keypad to interact with a remote data processing system also requires a continuous connection over the telephone network whilst interaction takes place. In Uchiyama the interaction between the user and the system is displayed on the display device, which is typically a large screen at the venue.

The invention of claim 39 uses a totally different approach, and is truly applicable in situations where a jukebox is desired - a jukebox that can play tracks continuously, whilst people can also select them continuously. The invention relies on using a mobile telephone alone to select a track by sending an SMS text message. Such a message can be composed on the mobile telephone, and then sent. In Uchiyama, tracks are selected using a phone keypad, but that is in association with a menu that is provided from a remote location and displayed on a video monitor. In accordance with claim 39, the selection of tracks is carried out using SMS text messaging from a mobile phone so public display screens are not necessary for that purpose. Screens can be provided for other purposes, such as displaying videos or displaying messages associated with track requests, but there will be no interruption whilst a user goes through menus to select another track. Any number of people at the venue can be involved selecting tracks concurrently, and it is not necessary to wait whilst one person completes selection using a public display screen as in Uchiyama.

Independent claim 41 is a new claim which focuses on the interaction between the user and the jukebox when a user wants to search for tracks. Again, the tracks are stored on the jukebox at the venue, and again a mobile telephone is used to select tracks on the jukebox. In Uchiyama, if a user wants to look through available tracks, there must be information displayed on the public screen at the venue, and the user looks at that, decides on an option, and presses the phone keypad corresponding to the number of that option. Whilst this process is being carried

out, the screen cannot be used by other people at the venue, whether to select tracks or to view information. In accordance with claim 40, search criteria are input as text into the mobile telephone, and transmitted. Text search results are then transmitted back to the mobile telephone, the user selects a desired track in the search results, using the mobile telephone, and the selected track request is transmitted by the mobile telephone. Thus, the user has a simple way of searching for and selecting a track, whilst not using a public display at the venue. The experience for the user is more convenient for the user selecting a track, and for other users who want to view a video or other information on the public screen. Nowhere in Uchiyama is such an arrangement suggested.

Dependent claims 42 and 43 recite that WAP and SMS are used, respectively.

New claims 25-43 are not anticipated by Uchiyama nor are they rendered obvious by the combination of Uchiyama in view of Newnam. Accordingly, Applicant requests the Examiner to pass new claims 25-43 to allowance.

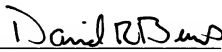
**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 227-7400.

If any additional fee is due with this statement, please charge our Deposit Account No. 12-0080, under Order No. FBU-001, from which the undersigned is authorized to draw.

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Respectfully submitted,

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